

CS-99-224



GP
2815

January 4, 2002

To: Commissioner of Patents and Trademarks

Washington, D.C. 20231

Attn: Art Unit 2815 - Eugene Lee

From: George O. Saile, Reg. No. 19,572

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Poughkeepsie, N. Y., 12603

Subject: | Serial No.: 09/755,572 01/08/01 |

Ting Cheong Ang et al.

NOVEL METHOD OF BODY CONTACT FOR
SOI MOSFET

| _ Art Group: 2815 Eugene Lee _ |

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction or Election Requirement in the Office Action dated 12/21/01. In that Office Action, restriction was required to one of two stated

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on January 9, 2002.

Stephen B. Ackerman, Reg.# 37761

Signature/Date SB/D 1/9/02

Inventions under 35 U.S.C. 121. The Inventions stated are Group I - Claims 14-20 to a semiconductor device, classified in Class 257, subclass 347 and Group II - Claims 1-13 to a process, classified in Class 438, subclass 1+.

Applicant provisionally elects to be examined the Invention described by the Examiner as Group II - Claims 1-13 drawn to a process classified in Class 438, subclass 1+. This election is made with traverse of the requirement under 37 C.F.R.1.143 for the reasons given in the following paragraphs.

The Examiner is respectfully requested to reconsider the Requirement for Restriction given in the Office Action. The Examiner gives the reason for the distinctness of the two inventions as (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). However, upon reading the product Claims against the process Claims one can readily see that the product Claims are directed to "a silicon-on-insulator device in an integrated circuit" and the process Claims are directed to "a method of forming a silicon-on-insulator device in the fabrication of integrated circuits", it is necessary to obtain claims in both the product and method claim language. The method Claims necessarily use the product and vice versa. The field of search must necessarily cover both the method class/subclass 438/1+ and products class 257/347 in addition to

other related Classes and subclasses to provide a complete and adequate search. The fields of search for the Group I and Group II inventions are clearly and necessarily co-extensive. The Examiner's suggestion that "In the instant case the product as claimed can be made by another and materially different process. For example, as an alternative to the methods set forth in claims 14-20, instead of etching the first and second trenches in separate steps, one could form the trenches simultaneously.", is very speculative and really has nothing to do with the Claims as presented in this Patent Application. It is believed, and will be assumed for purposes of election, that the Examiner intended to state Claims 1-13 since these are the process Claims, instead of Claims 14-20. Further, it is respectfully suggested that these reasons are insufficient to place the additional cost of a second Patent Application upon the Applicants. Therefore, it is respectfully requested that the Examiner withdraw this restriction requirement for these reasons.

Withdrawal of the Restriction Requirement and the Allowance of the present Patent Application is requested.

Sincerely

A handwritten signature in dark ink, appearing to read 'SBA', with a long horizontal flourish extending to the right.

Stephen B. Ackerman, Reg. #37761